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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,351	02/21/2001	Takayuki Usui	Q61689	1061

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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
Suite 800
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,351

Applicant(s)

USUI ET AL.

Examiner

Walter B. Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006 and 24 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. Applicant's amendments in claim 23 in the Amendment filed March 22, 2006 (Amdt. H) have been received and considered by Examiner.
2. New claim 30 presented in Amdt. H has been received and considered by Examiner.
3. The Declaration under 37 CFR 1.132 filed April 24, 2006 has been received and considered by Examiner.

REPEATED REJECTIONS

Claim Rejections - 35 USC § 103

4. The 35 U.S.C. 103 rejections of claims 13-18 and 22 that were repeated in paragraph 7 of the previous Office Action mailed September 22, 2005 have been repeated for the reasons previously made of record.
5. The 35 U.S.C. 103 rejection of claims 1, 2, 7-10, 19-21, 24, 26 and 27 that was repeated in paragraph 8 of the previous Office Action mailed September 22, 2005 has been repeated for the reasons previously made of record.
6. The 35 U.S.C. 103 rejection of claims 3, 5 and 11 that was repeated in paragraph 9 of the previous Office Action mailed September 22, 2005 has been repeated for the reasons previously made of record.
7. The 35 U.S.C. 103 rejection of claims 4, 6 and 12 that was repeated in paragraph 10 of the previous Office Action mailed September 22, 2005 has been repeated for the reasons previously made of record.

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8. The 35 U.S.C. 103 rejection of claim 23 that was repeated in paragraph 11 of the previous Office Action mailed September 22, 2005 has been repeated for the reasons previously made of record, and for the following reason that addresses the amendments made in claim 23 in Amdt. H: the recitation “are determined based on facilitating separation of the packaging material from the planographic printing plate during automatic feeding and preventing damage to the image surface of the printing plate” is a method limitation that has not been given patentable weight since the method of determining the different Bekk smoothnesses of the two surfaces is not germane to the issue of patentability of the package sheet structure itself.

9. The 35 U.S.C. 103 rejection of claim 28 that was repeated in paragraph 12 of the previous Office Action mailed September 22, 2005 has been repeated for the reasons previously made of record.

10. The 35 U.S.C. 103 rejection of claim 29 made of record in paragraph 13 of the previous Office Action mailed September 22, 2005 has been repeated for the reasons previously made of record.

NEW OBJECTIONS

Specification

11. The amendment filed March 22, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the recitation “the different Bekk smoothnesses of the two surfaces are determined based on facilitating separation of the packaging material from the planographic printing plate during automatic feeding and preventing

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damage to the image surface of the printing plate” of claim 23 and the recitation “the opposing surface of the sheet material has a Bekk smoothness value from 3 seconds to less than 5 seconds” of claim 30.

Applicant is required to cancel the new matter in the reply to this Office Action.

NEW REJECTIONS

Claim Rejections - 35 USC § 112

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 23 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In regard to claim 23, the recitation “the different Bekk smoothnesses of the two surfaces are determined based on facilitating separation of the packaging material from the planographic printing plate during automatic feeding and preventing damage to the image surface of the printing plate” is not supported in the specification as originally filed. In regard to claim 30, the recitation “the opposing surface of the sheet material has a Bekk smoothness value from 3 seconds to less than 5 seconds” is not supported in the specification as originally filed: a range of “from 3 seconds to less than 5 seconds” for either surface is not supported in the specification as originally filed.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 23 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 23, the recitation “the different Bekk smoothnesses of the two surfaces are determined based on facilitating separation of the packaging material from the planographic printing plate during automatic feeding and preventing damage to the image surface of the printing plate” renders the claim indefinite since it cannot be ascertained what Applicant intends to recite by “the different Bekk smoothnesses of the two surfaces are determined”: what entails “determin[ing]” different Bekk smoothnesses of two surfaces? Furthermore, it cannot be ascertained how “facilitating separation of the packaging material from the planographic printing plate during automatic feeding” and “preventing damage to the image surface of the printing plate” would contribute to “determin[ing]” different Bekk smoothnesses of two surfaces.

In regard to claim 30, the recitation “the opposing surface of the sheet material has a Bekk smoothness value from 3 seconds to less than 5 seconds” renders the claim indefinite since the endpoint of the range delineated by “less than 5 seconds” cannot be ascertained: any value less than 5, including any value less than 3, falls within the scope of “less than 5”, so this recitation recites the range of “3 to x” where x is any value that is less than 5, which represents an infinite amount of ranges.

Response to Arguments

16. Applicant’s arguments presented on pages 10-13 of Amdt. H regarding the rejections based on Hayashi, Coppens and Usui have been fully considered but are not persuasive.

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Applicant states on page 10 of Amdt. H that “Examiner alleges that [something] would necessarily include the density as disclosed by Usui” (it is not clear what Applicant is alleging that the Office Action states “necessarily include[s] the density as disclosed by Usui”: that is, it is not clear what Applicant intends the [“something]” used three lines above in this Office Action to be). Regardless of what Applicant intends to state here, the Office Action does not state anything to the effect that anything “necessarily include[s] the density as disclosed by Usui”. Applicant cites page 6 of the previous Office Action (mailed September 22, 2005), and the substance of the rejection is very clearly provided on this page of the previous Office Action. The Office Action does not state anything to the effect that “a particular density would necessarily [sic] flow from the air permeability disclosed by Usui”. Applicant has not addressed the basis of the rejection on page 10 of Amdt. H.

In response to Applicant’s arguments in the first full paragraph of page 11 of Amdt. H, there is motivation to use the density of 0.8g/cc taught by Usui, which falls within the claimed range, as the density of the interleaf since Embodiment 1 of Usui, which has a density of 0.8g/cc, necessarily has an air permeability that falls within the required range of Usui (and therefore within the range of suitable values as taught by Usui) since it is an embodiment of Usui.

On page 11 of Amdt. H, Applicant refers to, and repeats, an argument presented on pages 12-16 of the Amendment filed July 30, 2004 and on page 14 of the After Final Amdt. filed March 29, 2005. The Office’s response to this argument is in the paragraph bridging pages 14 and 15 of the previous Office Action mailed October 29, 2004. In response to Applicant’s argument that the three patents relied upon in the rejection are intended to store different items, and therefore the three references cannot be combined, the Office repeats that which is stated in

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the paragraph bridging pages 14 and 15 of the previous Office Action mailed October 29, 2004 and also notes that the particular item that is intended to be stored in any of the packages of the three references is a matter of intended use, and one of ordinary skill in the art would have recognized to have varied the properties of the particular interleaf in order to accommodate the particular item that is intended to be stored.

Applicant's statements in the last four full sentences of page 12 of Amdt. H are unsupported. The purpose of Hayashi is not to "evaluate storage performance".

17. Applicant's arguments presented on pages 14-16 of Amdt. H regarding the rejection based on Coppens, Hayashi and Busch have been fully considered but are not persuasive.

Applicant's Representative misrepresents the substance of the rejection under 35 U.S.C. 103 of record in the first full paragraph of page 14 of Amdt. H. The Office Action does not state, or even suggest, that "since Hayashi discloses a paper having smooth surfaces with Bekk smoothness of 5 to 10,000 seconds, then having two surfaces with different Bekk smoothness values is obvious" as Applicant's Representative writes on page 14 of Amdt. H. Applicant's Representative has ignored the role that Busch plays in the basis of the rejection, and has therefore not addressed the rejection of record. It is also unclear which Office Action Applicant's Representative refers to parenthetically in the first full paragraph of page 14 of Amdt. H. The remainder of Applicant's discussion regarding the 35 U.S.C. 103 rejection of claim 23 similarly ignores the rejection of record. Busch is briefly mentioned in one sentence on page 15 of Amdt. H, but the role of Busch in the rejection of record is not addressed.

18. Applicant's arguments presented on pages 16-17 of Amdt. H regarding the rejection based on Coppens and Hayashi have been fully considered but are not persuasive.

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The paper spacer of Coppens is a “means for preventing...” as claimed since the spacer of Coppens that packages the planographic printing plate has a surface that contacts the imaging surface of the planographic printing plate (col. 3, lines 41-43).

Response to Declaration under 37 CFR 1.132 filed April 24, 2006

19. The Declaration under 37 CFR 1.132 filed April 24, 2006 has been fully considered but is not persuasive.

Declarant, who is also one of the two Applicants of the instant application, states that “there is no correlation or interrelationship between density and air permeability” on page 2 of the Declaration, but the Office Action does not allege that there is. The chart merely provides the endpoints of the range that the Office Action cites from the Usui patent on page 6 (previous Office Action mailed September 22, 2005). The data provided in the column furthest to the right regarding the “Usui 2” reference is inconclusive since all the air permeability values are reported as “1000 or above”. Declarant has not explained how this statement and chart addresses the rejection of record, and Applicant’s Representative has not explained how this statement and chart addresses the rejection of record on page 11 of Amdt. H.

Declarant alleges “remarkabl[e]” results (and presumably, unexpected results) in the lines immediately before each graph in section 2 of the Declaration, but Applicant has not met the burden on Applicant to establish that these results are unexpected and significant in that the evidence relied upon does not establish “that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance”. MPEP 716.02. Applicant’s statement on page 13 of Amdt. D that “the interleaf of Hayashi would be almost unpeelable from the printing plate of Coppens” is not supported in the Declaration. Declarant’s statements

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contradict Applicant's statement that "if the interleaf of Hayashi is applied to the printing plate of Coppens, the storage of the printing plate of Coppens will be ineffective" in that some values disclosed by Hayashi are characterized as "good" or "sufficient" by Declarant.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is to 571-273-8300.

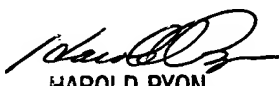
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

07/06/06

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
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7/7/06